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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,853	01/22/2004	Robert Sesek	200206923-1	5874
22879 7590 04/29/2008 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400				
EXAMINER WILLIAMS, JAMELA O				
ART UNIT		PAPER NUMBER		
3722				
NOTIFICATION DATE		DELIVERY MODE		
04/29/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/762,853

Applicant(s)

SESEK ET AL.

Examiner

JAMILA WILLIAMS

Art Unit

3722

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 20, 21, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 20, 21, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date _____
- 6) ☐ Other: _____

DETAILED ACTION

In view of the Appeal Brief filed on 12-4-2007, PROSECUTION IS HEREBY REOPENED. A new rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 20, it is unclear how the "means for navigating.." and "means for orienting..." further limit the guide book.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over 4,965,948 to Ruebens.

Ruebens discloses a photography guidebook comprising a plurality of blank photograph locations (22) and a plurality of writing surfaces (34) with indicia imprinted thereon (35,36).

Ruebens discloses the claimed invention expect for the specific arrangement and/or content of the indicia (printed matter) set forth in the claims (i.e. photograph descriptions including one or more of camera location, coordinates, magnetic bearing of the lens, inclination of camera, shutter speed, an aperture, a plurality of environmental conditions, film type, recited in claim 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to alter the indicia since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In re Gulack, 217

USPQ 401 (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information/instruction does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (photograph descriptions) and the substrate (guidebook) that is required for patentability.

Regarding claims 3-4, Ruebens discloses that the descriptions are placed in a portion of the guidebook separate from the photograph locations, the descriptions are placed adjacent their photograph locations (see figure 1 for example).

Regarding claim 5, Ruebens discloses that the descriptions comprise a caption for the photograph and a set of technical details of the photograph locations (see figure 1 and the In re Gulack rejection above).

Regarding claim 6, Ruebens discloses that the technical details are placed in a portion of the guidebook separate from the photograph locations and captions (figure 1).

Regarding claims 7-9 see rejections of claims 1-3 above.

Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over 6,257,621 to Smith in view of 965,948 to Ruebens. Smith discloses a system comprising a camera and guidebook having a plurality of blank photograph locations (see fig 1 and column 3 lines 50-53 of Smith)

Smith does not show a plurality of preprinted photograph descriptions of the blank photograph locations.

Ruebens teaches having preprinted indicia associated with the photos (35,36).

Regarding the specific arrangement and/or content of the indicia (printed matter) set forth in the claims (i.e. photograph descriptions including one or more of camera location, coordinates, magnetic bearing of the lens, inclination of camera, shutter speed, an aperture, a plurality of environmental conditions, film type recited in claim 11), it would have been obvious to one having ordinary skill in the art at the time the invention was made to alter the indicia since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In re Gulack, 217 USPQ 401 (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information/instruction does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (photograph descriptions) and the substrate (guidebook) that is required for patentability.

Regarding claim 12, Smith (modified by Ruebens) discloses the descriptions are placed in a portion of the guidebook separate from the photograph locations (figure 1 of Ruebens).

Regarding claim 13, Smith (modified by Ruebens) discloses the descriptions are placed adjacent their respective photograph locations (figure 1 of Ruebens).

Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over 6,257,621 to Smith in view of 6,930,715 to Mower.

Smith discloses a guidebook comprising means for retrieving photograph details in a guidebook (pages 14 capable of receiving text). Smith further discloses having a camera (18) associated therewith. However Smith does not disclose the specific functionality of the camera (i.e. having means for navigating to a photograph taking location and means for orienting the camera according to retrieved photograph details).

Mower teaches having a camera having a means for navigating to a photograph taking location and means for orienting the camera according to the retrieved photograph details (column 2 lines 50-67 and column 3 lines 1-11- since Mower teaches the use of analog compass and inclinometer that allows for data to be input manually into the computing unit of the camera, the examiner takes the position that this manually entered information could be gathered from a book or written document).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the teachings of Mower with the system of Smith for the purpose of providing a more detailed camera image.

Regarding claim 21, Smith (modified by Mower) discloses the claimed invention except for the specific arrangement and/or content of the indicia (printed matter) set forth in the claims (i.e. photograph details including at least one of a camera location, coordinates, magnetic bearing of the lens, inclination of camera, shutter speed, an aperture, a plurality of environmental conditions, film type).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to alter the indicia since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401 (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information/instruction does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (photograph descriptions) and the substrate (guidebook) that is required for patentability.

Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over 6,257,621 to Smith in view of Reubens and further in view of 6,930,715 to Mower

Smith discloses having a system comprising a book with pages and a camera (pages 14, camera 18). Smith further discloses the pages are capable of supporting text.

Smith does not show a plurality of preprinted technical details for identifying each of the blank photograph locations and means for replicating the technical details (although Smith discloses a camera, it is not specific to the functionality of the camera).

Ruebens teaches having preprinted indicia associated with the photos (35,36).

Regarding the specific arrangement and/or content of the indicia (printed matter) set forth in the claims (i.e. photograph descriptions including one or more of camera location, coordinates, magnetic bearing of the lens, inclination of camera, shutter speed, an aperture, a plurality of environmental conditions, film type recited in claim 11), it would have been obvious to one having ordinary skill in the art at the time the invention was made to alter the indicia since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In *re Gulack*, 217 USPQ 401 (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information/instruction does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (photograph descriptions) and the substrate (guidebook) that is required for patentability.

Mower teaches having a camera with a GPS system providing position coordinates (figure 2 and column 4 lines 53-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the preprinted indicia teaching of Reubens and means of the camera of Mower for the purpose of providing information in the guidebook and for the purpose of providing a more detailed photo image.

Response to Arguments

Applicant's arguments filed 12-4-2007 have been fully considered but they are not persuasive.

Upon review of the arguments associated with the appeal brief and the amendment to claims 20-21 prosecution is being reopened to move clearly address the "means" of claims.

Regarding applicant's arguments towards the application of Gullack for the content/arrangement of the indicia, the examiner maintains that indicia of applicant's guide book merely provides information to the user. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information/instruction does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (printed photograph descriptions/ technical details) and the substrate (guidebook) that is required for patentability.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMILA WILLIAMS whose telephone number is (571)272-4431. The examiner can normally be reached on Monday-Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Derris H Banks/
Supervisory Patent Examiner, Art Unit 3725

/J. W./
Examiner, Art Unit 3722